

REMARKS

Claim 27 has been amended. Claims 41- 44 have been canceled without prejudice or disclaimer. Claims 60-63 have been added.

Responsive to the action mailed October 1, 2004, Applicants elect the invention of Group I (claims 1-8 and 11-12) drawn to the embodiment of a method of identifying a target-binding protein. The election is made with traverse.

Applicants respectfully request that the Examiner withdraw the restriction requirement with respect to Groups I, II, III, and IV because the claims of Groups II-IV depend from claim 1 (a claim that is a member of Group I). Restriction is only appropriate if the inventions are independent or distinct. According to MPEP § 802.01, "'Independent', of course, means not dependent." Here, where claims 9, 10 and 13 and new claims 60-63 depend from claim 1, they cannot be independent. "Distinct" means "related ... but... capable of separate ... use" *Id.* Applicants are unclear on how claims 9, 10, and 13 can be used separately from claim 1 because claim 1 must be performed when the methods of these claims are performed. Finally, there can be no undue burden on the Examiner because if claim 1 is found to be patentable over the art, claims 9, 10, and 13 and 60-63, because they depend from claim 1, must also be patentable.

Applicants respectfully request that the Examiner withdraw the restriction requirement with respect to Groups VI, VII, and XV. Like the method of claim 1, the claims of Groups VI (claims 15 and 16), and VII (claims 17-23) relate to identifying a target-binding protein. In particular, given their close relationship, Applicants cannot exclude the possibility that some implementations of a claim restricted from Group I might also be within the scope of claim 1.

As an illustration, new claim 60 depends from claim 1 but also closely corresponds to the related method of claim 17.

The claims of Group XV (claims 58 and 59) relate to providing an agent that has been selected for its ability to bind to a target molecule and for its ability to bind serum albumin. Some implementations of claims 58 and 59 of Group XV might also be within the scope of claims 1, 15, and 17.

The Examiner has not asserted that there is an undue burden to search the inventions of the different groups. MPEP § 808.02 requires an appropriate explanation in the form of a separate classification, a separate status in the art, or a different field of search for the restricted inventions. The Examiner states on page 5 of the most recent action that the inventions “have acquired a separate status in the art.” However, since the claims of Groups II-IV, VI-VII, and XV all pertain to methods of identifying or selecting a target-binding protein, it would appear that, contrary to the Examiner's view, they do not have a separate status in the art.

The Examiner also states on page 5 that the search required for Group I is not required for Groups II-XV. Since the search for Group I may be more extensive than the search required for some groups, and co-extensive to a significant degree with the search required for other groups, then allowing these groups to be in the same application as Group I would not be unduly burdensome and serves the interest of efficiency by avoiding piece-meal prosecution.

No statement herein is an admission that any claim is not patentably distinct from another or that any claim is obvious over another.

To summarize, Applicants respectfully traverse as to the restriction between Groups I and Groups II-IV, VI, VII, and XV, and request that the Examiner withdraw the restriction requirement with respect to these groups and examine claims 1-13, 15-23, 58-59, and new claims 60-63 in the same application. At least claim 14 (Group V) should be rejoined upon allowance of a linking claim such as claim 1.

Applicants reserve the right to rejoin any claim, including a claim of the group traversed above or of Groups V and VIII-XV as appropriate and to traverse the restriction between the remaining groups at a later date.

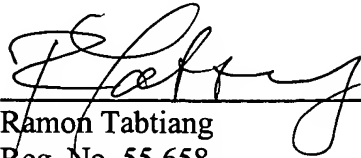
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Respectfully submitted,

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